



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,452	08/26/2003	Ryoji Watanabe	116867	3239

25944 7590 02/20/2008
OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

POPOVICI, DOV

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

02/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/647,452

Applicant(s)

WATANABE ET AL.

Examiner

Dov Popovici

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


DOV POPOVICI
PRIMARY PATENT EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/26/03 & 9/21/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7-8 are claiming a program per se. Claims 7-8 are directed to non-statutory functional descriptive material. "Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. " " Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory

functional descriptive material" (see Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka Akira et al. (JP 2000285203) in view of Akiba Tomohiro (JP 11-187247).

As to claim 1, Tanaka Akira et al. discloses an image forming system comprising: an-image display member (paper incorporating an IC chip; see abstract) on which an image is displayed; and an image forming apparatus, wherein: the image display member (paper incorporating an IC chip; see abstract) includes: an information storage section (IC chip see abstract) for storing information, which is written from external there into, and supplying the stored information to the external; and the image forming apparatus include: a reception section for receiving a input from the external; an image reading section (IC reader/writer 50) for reading the displayed image; an image forming section for forming the read image in accordance with the received data; and an information writing section (IC reader/writer 50) for writing information indicating the received data into the information storage section (IC chip).

Tanaka Akira et al. do not specifically teach or specifies that the image forming apparatus include: a setting reception section for receiving a setting input from the external; an image forming section for forming the read image in accordance with the received setting; and an information writing section for writing setting information indicating the received setting into the information storage section.

Akiba Tomohiro teaches an image forming device with an image processing means capable of incorporating setting information regarding an instruction executed by an operator into a specified plate of image data in a specified form. This image forming device is provided with an image processing means capable of incorporating the setting information regarding the instruction executed by the operator into a specified place of the image data in the specified form. In this device, various kinds of image processing are performed for the image data transmitted from recognition part 12 through an image processing part 14. Then the specified setting information is added to the image data. For example, ciphered secondary bar code information is added to the part of an image as the setting information. When an original is copied, if the start of copying is executed at a state of a setting information adding mode, the setting information is added to the specified plate (for example, a blank part) in a specified form (for example, a bar code) in the image processing part 14 and outputted on a sheet. Thus, original can be copied with the same setting, without the setting of various functions by the operator (see abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. wherein: the

image forming apparatus include: a setting reception section for receiving a setting input from the external; an image forming section for forming the read image in accordance with the received setting; and an information writing section for writing setting information indicating the received setting into the information storage section.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. by the teaching of Akiba Tomohiro for the reasons taught by Akiba Tomohiro (see abstract) which is mainly to reduce mis-operations and at the same time save time by providing an image forming device with an image processing means capable of incorporating setting information regarding an instruction executed by an operator into a specified plate of image data in a specified form and so that the original can be copied with the setting, without the setting of various functions by the operator (see Akiba Tomohiro's abstract).

As to claim 2, Tanaka Akira et al. as modified discloses wherein: the information storage section (IC chip) supplies the written setting information to the external; the image forming apparatus further includes an information reading section (IC reader/writer 50) for reading the supplied setting information; and when the setting information is read, the image forming section forms the read image in accordance with the read setting information.

As to claim 3, Tanaka Akira et al. discloses an image forming apparatus for forming an image displayed on an image display member (paper incorporating an IC chip; see abstract), which stores information written from an external there into and

supplies the stored information to the external, the image forming apparatus comprising: a reception section for receiving a input from the external; an image reading section for reading the displayed image; an image forming section for forming the read image in accordance with the received information; and an information writing section for writing information indicating the received information/data into the information storage section (IC chip).

Tanaka Akira et al. do not specifically teach or specifies that the image forming apparatus include: a setting reception section for receiving a setting input from the external; an image forming section for forming the read image in accordance with the received setting; and an information writing section for writing setting information indicating the received setting into the information storage section.

Akiba Tomohiro teaches an image forming device with an image processing means capable of incorporating setting information regarding an instruction executed by an operator into a specified plate of image data in a specified form. This image forming device is provided with an image processing means capable of incorporating the setting information regarding the instruction executed by the operator into a specified place of the image data in the specified form. In this device, various kinds of image processing are performed for the image data transmitted from recognition part 12 through an image processing part 14. Then the specified setting information is added to the image data. For example, ciphered secondary bar code information is added to the part of an image as the setting information. When an original is copied, if the start of copying is executed at a state of a setting information adding mode, the setting information is added to the

specified plate (for example, a blank part) in a specified form (for example, a bar code) in the image processing part 14 and outputted on a sheet. Thus, original can be copied with the same setting, without the setting of various functions by the operator (see abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. wherein: the image forming apparatus include: a setting reception section for receiving a setting input from the external; an image forming section for forming the read image in accordance with the received setting; and an information writing section for writing setting information indicating the received setting into the information storage section.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. by the teaching of Akiba Tomohiro for the reasons taught by Akiba Tomohiro (see abstract) which is mainly to reduce mis-operations and at the same time save time by providing an image forming device with an image processing means capable of incorporating setting information regarding an instruction executed by an operator into a specified plate of image data in a specified form and so that the original can be copied with the setting, without the setting of various functions by the operator (see Akiba Tomohiro's abstract).

As to claim 4, Tanaka Akira et al. as modified discloses the image display member (paper incorporating an IC chip; see abstract) supplies the written setting information to the external, the image forming apparatus further comprising: an

information reading section (IC reader/writer 50) for reading the supplied setting information, wherein: when the setting information is read, the image forming section forms the read image in accordance with the read setting information.

As to claim 5, Tanaka Akira et al. discloses an image forming method for forming an image displayed on an image display member (paper incorporating an IC chip; see abstract), which stores information written from an external there into and supplies the stored information to the external, the image forming method comprising: receiving a input from the external; reading the displayed image; forming the read image in accordance with the received information; and writing information indicating the received information/data into the image display member (paper incorporating an IC chip).

Tanaka Akira et al. do not specifically teach or specifies that the image forming method include: receiving a setting input from the external; forming the read image in accordance with the received setting; and writing setting information indicating the received setting into the image display member.

Akiba Tomohiro teaches an image forming device with an image processing means capable of incorporating setting information regarding an instruction executed by an operator into a specified place of image data in a specified form. This image forming device is provided with an image processing means capable of incorporating the setting information regarding the instruction executed by the operator into a specified place of the image data in the specified form. In this device, various kinds of image processing are performed for the image data transmitted from recognition part 12 through an image

processing part 14. Then the specified setting information is added to the image data. For example, ciphered secondary bar code information is added to the part of an image as the setting information. When an original is copied, if the start of copying is executed at a state of a setting information adding mode, the setting information is added to the specified plate (for example, a blank part) in a specified form (for example, a bar code) in the image processing part 14 and outputted on a sheet. Thus, original can be copied with the same setting, without the setting of various functions by the operator (see abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. wherein: the image forming method include: receiving a setting input from the external; forming the read image in accordance with the received setting; and writing setting information indicating the received setting into the image display member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. by the teaching of Akiba Tomohiro for the reasons taught by Akiba Tomohiro (see abstract) which is mainly to reduce mis-operations and at the same time save time by providing an image forming device with an image processing means capable of incorporating setting information regarding an instruction executed by an operator into a specified plate of image data in a specified form and so that the original can be copied with the setting, without the setting of various functions by the operator (see Akiba Tomohiro's abstract).

As to claim 6, Tanaka Akira et al. as modified discloses the image display member (paper incorporating an IC chip; see abstract) supplies the written setting information to the external, the image forming method further comprising: reading (IC reader/writer 50) the supplied setting information, wherein: when the setting information is read, the read image is formed in accordance with the read setting information in the image forming step.

As to claim 7, Tanaka Akira et al. discloses a program making a computer of an image forming apparatus form an image display on an image display member (paper incorporating an IC chip; see abstract) which stores information written from external there into and supplies the written information to the external, the program making the computer perform a process comprising: receiving a input from the external; reading the displayed image; forming the read image in accordance with the received information/data; and writing information/data indicating the received information/data into the image display member (paper incorporating an IC chip; see abstract).

Tanaka Akira et al. do not specifically teach or specifies that the program making the computer perform a process include: receiving a setting input from the external; forming the read image in accordance with the received setting; and writing setting information indicating the received setting into the image display member.

Akiba Tomohiro teaches an image forming device with an image processing means capable of incorporating setting information regarding an instruction executed by an operator into a specified plate of image data in a specified form. This image forming

device is provided with an image processing means capable of incorporating the setting information regarding the instruction executed by the operator into a specified place of the image data in the specified form. In this device, various kinds of image processing are performed for the image data transmitted from recognition part 12 through an image processing part 14. Then the specified setting information is added to the image data. For example, ciphered secondary bar code information is added to the part of an image as the setting information. When an original is copied, if the start of copying is executed at a state of a setting information adding mode, the setting information is added to the specified plate (for example, a blank part) in a specified form (for example, a bar code) in the image processing part 14 and outputted on a sheet. Thus, original can be copied with the same setting, without the setting of various functions by the operator (see abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. wherein: the program making the computer perform a process include: receiving a setting input from the external; forming the read image in accordance with the received setting; and writing setting information indicating the received setting into the image display member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Tanaka Akira et al. by the teaching of Akiba Tomohiro for the reasons taught by Akiba Tomohiro (see abstract) which is mainly to reduce mis-operations and at the same time save time by providing an image forming device with an image processing means capable of incorporating setting information

regarding an instruction executed by an operator into a specified plate of image data in a specified form and so that the original can be copied with the setting, without the setting of various functions by the operator (see Akiba Tomohiro's abstract).

As to claim 8, Tanaka Akira et al. as modified discloses the image display member (paper incorporating an IC chip; see abstract) supplies the written setting information to the external, the process further comprising: reading (IC reader/writer 50) the supplied setting information, wherein: when the setting information is read, the read image is formed in accordance with the read setting information in the image forming step.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kohama et al. (US 5,856,662) teaches an IC chips on a substrate and a reader-writer (see column 1, lines 5-20).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

Application/Control Number:
10/647,452
Art Unit: 2625

Page 13

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dov Popovici
Primary Examiner
Art Unit 2625

DOV POPOVICI
PRIMARY PATENT EXAMINER